

REMARKS:

Claims 1-14 are currently pending in the Application. Claims 6-14 stand rejected under 35 U.S.C. § 112, second paragraph. Claims 1-14 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,549,818 to *Ali* ("Ali").

By this Amendment, the Applicants have amended claims 1-14 in an effort to expedite prosecution of this Application and to more particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. By making these amendments, the Applicants make no admission concerning the merits of the Examiner's rejection, and respectfully deny any statement or averment of the Examiner not specifically addressed. Particularly, the Applicants reserve the right to file additional claims in this Application or through a continuation patent application of substantially the same scope of originally filed claims 1-14. No new matter has been added.

REJECTION UNDER 35 U.S.C. § 112:

Claims 1-14 stand rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. The Applicants respectfully disagree.

Nonetheless, the Applicants have amended claims 1-14 in an effort to expedite prosecution of this Application and to more particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. By making these amendments, the Applicants do not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 112, as set forth in the Office Action. Particularly, the Applicants reserve the right to file additional claims in this Application or through a continuation patent application of substantially the same scope of originally filed claims 1-14.

The Applicants respectfully submit that claims 1-14 are considered to be in full compliance with the requirements of 35 U.S.C. § 112. The Applicants further submit that claims 1-14 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of claims 1-14 under 35 U.S.C. § 112 be reconsidered and that claims 1-14 be allowed.

REJECTION UNDER 35 U.S.C. § 103(a):

Claims 1-14 stand rejected under 35 U.S.C. § 103(a) over *Ali* in view of the Examiner's Official Notice.

Although the Applicants believe claims 1-14 are directed to patentable subject matter without amendment, the Applicants have amended claims 1-14 to more particularly point out and distinctly claim the Applicants invention. By making these amendments, the Applicants do not indicate agreement with or acquiescence to the Examiner's position with respect to the rejections of these claims under 35 U.S.C. § 103(a), as set forth in the Office Action.

The Applicants respectfully submit that *Ali* or the Examiner's Official Notice, either individually or in combination, fails to disclose, teach, or suggest each and every element of claims 1-14. Thus, the Applicants respectfully traverse the Examiner's obvious rejection of claims 1-14 under 35 U.S.C. § 103(a) over the proposed combination of *Ali* or the Examiner's Official Notice, either individually or in combination.

The Proposed *Ali*-Official-Notice Combination Fails to Disclose, Teach, or Suggest Various Limitations Recited in Applicants Claims

For example, with respect to amended independent claim 1, this claim recites:

For use in a cooking device capable of accessing a communications system, ***a high speed oven for combining hot air impingement cooking and microwave cooking, said high speed oven comprising:***

a cooking chamber;

a programmable controller for executing program instructions;

memory media for recording executable program instructions;

at least one controllable cooking system under control of said programmable controller, providing a data-processing-controlled high speed cooking process for food placed in said cooking chamber;

a plurality of cooking programs recorded in said memory media of said high speed oven, each of said plurality of cooking programs divided into a predetermined duration of states in a cooking cycle which are capable of running for a predetermined percentage of a total cook time, wherein each of said plurality of cooking programs define a plurality of high speed cooking routines for alternating between hot air impingement cooking and microwave cooking at fixed increments of capacity for a predetermined time;

a gateway server communicatively coupled to a plurality of household systems and further communicatively coupled to said programmable controller for managing the communication of digital data content which is at least in-part related to operation and utilization of said high speed oven; and

a broadband communication channel extending from a source of digital data content, which is external to a residence, for delivering particular digital data content related to said high speed oven through said gateway server for distribution within said residence including distribution to said programmable controller of said high speed oven in order to facilitate cooking operations utilizing said high speed oven. (Emphasis Added).

Amended independent claim 8 recites similar limitations. *Ali* or the Examiner's Official Notice, either individually or in combination, fail to disclose each and every limitation of independent claims 1 and 8.

The Applicants respectfully submit that the Office Action acknowledges, and Applicants agree, that *Ali* fails to disclose the emphasized limitations noted above in independent claim 1. Specifically the Examiner acknowledges that "***Ali fails to teach the claimed limitation of a gateway server facilitating communication with network resources.***" (15 July 2005 Final Office Action, Page 4). However, the Examiner asserts "*Ali* does teach that the appliance computer 14 is connected to the oven controller and facilitates communication with external resources through a personal computer/ISP connection." (15 July 2005 Final Office Action, Page 4). The Applicants respectfully disagree. The Examiner further asserts Official Notice over the acknowledged shortcomings in *Ali*. (15 July 2005 Final Office Action, Page 4). The Applicants respectfully traverse the Examiner's assertions regarding the Official Notice taken by the Examiner.

The Applicants respectfully submit that *Ali* has nothing to do with independent claim 1 limitations regarding "***a high speed oven for combining hot air impingement cooking and microwave cooking***" and in particular *Ali* has nothing to do with independent claim 1 limitations regarding "***a gateway server communicatively coupled to a plurality of household systems and further communicatively coupled to said programmable controller for managing the communication of digital data content which is at least in-part related to operation and utilization of said high speed oven***". In addition, the Applicants respectfully submit that the Applicants are confused as to what the Examiner

teaches by the Examiner's Official Notice or even the extent in which the Examiner is taking Official Notice. In fact, the only reference to the Examiner's Official Notice that the Examiner asserts is "Official Notice is taken that the concept and advantages of using a gateway server for connecting to an Internet resource is old and well known in the art." (15 July 2005 Final Office Action, Page 4). The Applicants respectfully disagree.

The Applicants respectfully request clarification as to the subject matter for which the Examiner is taking Official Notice. The Applicants respectfully traverse the Official Notice because the asserted facts, as best understood by the Applicants, are not supported by substantial documentary evidence or any type of documentary evidence and appear to be the Examiner's opinions formulated using the subject Application as a template, which constitutes impermissible use of hindsight. Furthermore, under these circumstances, it is inappropriate for the Examiner to take Official Notice without documentary evidence to support the Examiner's conclusion. (See MPEP § 2144.03). ***The Applicants respectfully request the Examiner to produce authority for the Examiner's Official Notice.***

Only "in limited circumstances," is it "appropriate for an examiner to take official notice of facts not in the record or to rely on common knowledge in making a rejection". (MPEP § 2144.03). "Official notice unsupported by documentary evidence should only be taken by the examiner where the facts asserted to be well-known, or to be common knowledge in the art ***are capable of instant and unquestionable demonstration as being well-known***. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091, 165 USPQ 418, 420 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be '***capable of such instant and unquestionable demonstration as to defy the dispute***' (citing *In re Knapp Monarch Co.*, 296 F.2d 230, 132 U.S.P.Q. 6 (C.C.P.A. 1961))." (MPEP § 2144.03(A)). (Emphasis Added).

"It is never appropriate to rely solely on "common knowledge" in the art without evidentiary support in the record, as the principal evidence upon which a rejection was based. *Zurko*, 258 F.3d at 1385, 59 USPQ2d at 1697. As the court held in *Zurko*, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. *Id.* at 1385, 59 USPQ2d at 1697. See also

In re Lee, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002).” (MPEP § 2144.03(A)).

“Ordinarily, there must be some form of evidence in the record to support an assertion of common knowledge. See *Lee*, 277 F.3d at 1344-45, 61 USPQ2d at 1434-35 (Fed. Cir. 2002); *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (holding that **general conclusions concerning what is “basic knowledge” or “common sense” to one of ordinary skill in the art without specific factual findings and some concrete evidence in the record to support these findings will not support an obviousness rejection**). The examiner must provide specific factual findings predicated on sound technical and scientific reasoning to support his or her conclusion of common knowledge. See *Soli*, 317 F.2d at 946, 37 USPQ at 801; *Chevenard*, 139 F.2d at 713, 60 USPQ at 241. The applicant should be presented with the explicit basis on which the examiner regards the matter as subject to official notice and be allowed to challenge the assertion in the next reply after the Office action in which the common knowledge statement was made.” (MPEP § 2144.03(B)). (Emphasis Added).

The Applicants respectfully submit that the Office Action provides no documentary evidence to support the Official Notice taken by the Examiner, yet the asserted facts are not capable of “instant and unquestionable” demonstration as being well-known. The Applicants further submit that the Applicants have adequately traversed the Examiner’s assertion of Official Notice and direct the Examiner’s attention to the pertinent text of the MPEP, which states:

If applicant adequately traverses the examiner’s assertion of official notice, the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See 37 CFR 1.104(c)(2). See also *Zurko*, 258 F.3d at 1386, 59 USPQ2d at 1697 (“[T]he Board [or examiner] must point to some concrete evidence in the record in support of these findings” to satisfy the substantial evidence test). If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2). (MPEP § 2144.03(C)).

Thus, if the Examiner continues to maintain the rejection of claims 1-14 based on the Examiner’s Official Notice, the Applicants respectfully request that the Examiner

provide documentary evidence as necessitated by MPEP § 2144.03(C). Furthermore, if the Examiner is relying on personal knowledge to support the finding of what is known in the art, the Applicants further request that the Examiner provide an Affidavit or Declaration setting forth specific factual statements and explanation to support the finding as further necessitated by MPEP § 2144.03(C).

In addition, the Applicants respectfully point the Examiner to the pertinent sections of the MPEP, directly on point to determine whether the next Office Action should be made Final. In particular, the Applicants respectfully direct the Examiner's attention to MPEP § 2144.03(D), which states:

If the examiner adds a reference in the next Office action after applicant's rebuttal, and the newly added reference is added only as directly corresponding evidence to support the prior common knowledge finding, and it does not result in a new issue or constitute a new ground of rejection, the Office action may be made final. If no amendments are made to the claims, the examiner must not rely on any other teachings in the reference if the rejection is made final. ***If the newly cited reference is added for reasons other than to support the prior common knowledge statement and a new ground of rejection is introduced by the examiner that is not necessitated by applicant's amendment of the claims, the rejection may not be made final.*** (MPEP § 2144.03(D)). (Emphasis Added).

The Applicants further submit that the Office Action has failed to properly establish a *prima facie* case of obviousness based on the proposed combination of *Ali* or the Examiner's Official Notice, either individually or in combination. ***The Office Action has not shown the required teaching, suggestion, or motivation in these references or in knowledge generally available to those of ordinary skill in the art at the time of the invention to combine Ali or the Examiner's Official Notice as proposed.*** The Office Action merely states that it "would have been obvious to one of ordinary skill in the art at the time the invention modify *Ali* by specifying a gateway server for facilitating communication to the network in place of the appliance computer taught by *Ali*." (15 July 2005 Final Office Action, Pages 4-5). The Applicants respectfully disagree.

The Applicants further submit that this purported advantage relied on by the Examiner is nowhere disclosed, taught, or suggested in *Ali* or the Examiner's Official

Notice, either individually or in combination. The Examiner asserts that one of ordinary skill in the art at the time of the invention would have been motivated "to provide an interface between some external source of information and a server." (15 July 2005 Final Office Action, Pages 4-5). The Applicants respectfully disagree. ***The Applicants respectfully request the Examiner to point to the portions of Ali or the Examiner's Official Notice which contain the teaching, suggestion, or motivation to combine Ali or the Examiner's Official Notice for the Examiner's stated purported advantage.*** The Applicants further submit that the Examiner is using the subject Application as a template to formulate reconstructive hindsight, which constitutes impermissible use of hindsight under 35 U.S.C. § 103(a).

A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the ***prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art.*** *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). (Emphasis Added). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35. With respect to the subject Application, ***the Examiner has not adequately supported the selection and combination of Ali or the Examiner's Official Notice to render obvious the Applicant's claimed invention.*** The Examiner's conclusory statement that it would have been obvious to "modify Ali by specifying a gateway server for facilitating communication to the network in place of the appliance computer taught by Ali", does not adequately address the issue of motivation to combine. (15 July 2005 Final Office Action, Page 4). This factual question of motivation is material to patentability, and cannot be resolved on subjective belief and unknown authority. *Id.* It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to "[use] that which the inventor taught against its teacher." *W.L. Gore v. Garlock, Inc.*, 721 F.2d 1540 (Fed. Cir. 1983). Thus, ***the Office Action fails to provide proper motivation for combining the teachings of Ali or the Examiner's Official Notice, either individually or in combination.***

The Applicants Claims are Patentable over the Proposed Ali-Official-Notice Combination

As mentioned above, independent claims 1 and 8 are considered patentably distinguishable over *Ali* or the Examiner's Official Notice. With respect to dependent claims 2-7 and 9-14: claims 2-7 depend from amended independent claim 1 and claims 9-14 depend from amended independent claim 8. As mentioned above, each of independent claims 1 and 8 are considered patentably distinguishable over the proposed combination of *Ali* or the Examiner's Official Notice. Thus, dependent claims 2-7 and 9-14 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For at least the reasons set forth herein, the Applicants submit that claims 1-14 are not rendered obvious by the proposed combination of *Ali* or the Examiner's Official Notice. The Applicants further submit that claims 1-14 are in condition for allowance. Thus, the Applicants respectfully request that the rejection of claims 1-14 under 35 U.S.C. § 103(a) be reconsidered and that claims 1-14 be allowed.

THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there **must be some suggestion or motivation**, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) **must teach or suggest all the claim limitations**. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and **not based on applicant's disclosure**. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence

of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

CONCLUSION:

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.

Filed herewith is a Request for Three-Month Extension of Time Within the Third Month, a Request for Continued Examination (RCE)(with duplicate copy) PTO Form PTO/SB30(04-05) including suspension of action for three months, Associate Power of Attorney for David A. Bolton, and check # 9767 in the amount of \$1940.00 according to the following:

\$1020.00 Request For Response Within Third Month;

790.00 Request For Continued Examination with:

130.00 Suspension of Action for 3 months.

\$1940.00

Respectfully submitted,

January 17, 2006
Date



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